

REMARKS

A. Status of Claims.

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-13 and 15-17 have been previously canceled. Claims 14 and 18-31 are pending.

B. Response to Objection to Amendments to Specification.

The objection to the specification under 35 U.S.C. § 132(a) at Sections 1 and 2 of the Office Action has been rendered moot by the above amendments to the specification. Paragraph [0047] has been amended to be identical with Paragraph [0047] as originally filed.

C. Rejection of Claims 14 and 18-31 under 35 U.S.C. § 103(a) over Fischer alone or in View of Paragraph [0003] of Applicant's Specification is *Prima Facie* Improper.

1. Rejection of Claims 14 and 18-31.

At Section 3 of the Final Office Action, Claims 14 and 18-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,794,449 to Fischer (Fischer), taken either individually, or in view of applicant's alleged admissions on page 1, paragraph [0003] of the specification (Paragraph [0003]).

2. Requirements of MPEP § 706.02(j).

As set forth in MPEP § 706.02(j), "To establish a *prima facie* case of obviousness [under 35 U.S.C. § 103] . . . The prior art reference (or references) when combined must teach or suggest *all of the claim limitations*" (Emphasis added). For at least the following reasons, the rejection of claims 14 and 18-31 over Fischer, either alone or in view of Applicant's admissions, has failed to comply requirements of MPEP § 706.02(j), and,

therefore, has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

3. Final Office Action mischaracterizes Applicant's Response.

The following allegation in the Final Office Action mischaracterizes what was stated in Applicant's August 7, 2006 Amendment (Applicant's Response):

Allegation 1

Fisher is relied upon substantially as previously set forth in Paragraphs 3 and 4 and of Paper No. 050106, except that, as stated by applicant (Response, page 10), it is not directed at utilizing a pre-applied adhesive, but rather uses a peel-and-stick adhesive (See Final Office Action, p. 2).

First, the above allegation is incorrect, because Applicant does not use the term "peel-and-stick adhesive" anywhere in page 10 of Applicant's Response. In fact, Applicant does not use the term "peel-and-stick adhesive" anywhere in Applicant's Remarks section.

Furthermore, throughout the prosecution of the present application, Applicant has repeatedly attempted to amend the specification to use the terms "peel-and-stick adhesive" and "pre-applied adhesive" interchangeably (See, for example, Applicant's July 8, 2004 Preliminary Amendment). However, the Examiner has objected to the interchangeable use of these terms (See, for example, the Non-Final Office Action of May 5, 2006 at page 2). Throughout the prosecution of the present application, Applicant has continuously maintained that a "peel-and-stick" adhesive is a "pre-applied adhesive." A "pre-applied adhesive" is made into a "peel-and-stick" adhesive by placing on the adhesive a release liner or similar covering that is peeled away when the adhesive is ready to be used.

**4. Because the Final Office Action mischaracterizes Applicant's Response,
the Final Office Action has failed to rebut Applicant's Statement that
Claim 14 is patentable over Fischer.**

With respect to Claim 14, Applicant's point on page 10 was not that Claim 14 claimed a pre-applied adhesive instead of Fischer's peel-and-stick adhesive. Instead, Applicant argued the following:

Statement 1

Claim 14 as currently presented claims the feature of *adhering two or more building structure peripherals to one or more thermoplastic membranes using a pre-applied adhesive*, wherein the one or more thermoplastic membranes are adhered to a building structure. *Fischer does not teach or suggest adhering two or building structure peripherals to a thermoplastic membrane using a pre-applied adhesive*. Therefore, Claim 14 is patentable over Fischer for at least this reason (See Applicant's Response, p. 10, emphasis added).

However, the Final Office Action has failed to rebut any part of Applicant's Statement 1 above. In fact, because the Final Office Action mischaracterizes Applicant's arguments, as discussed above, the Final Office Action does not even address Applicant's Statement 1. Therefore, Applicant's Statement 1 must be regarded as being true. Accordingly, Fischer cannot teach or suggest Claim 14's feature of *adhering two or more building structure peripherals to one or more thermoplastic membranes using a pre-applied adhesive*.

5. Paragraph [0003] cannot remedy deficiencies of Fischer with respect to Fisher's failure to teach or suggest all of the features of Claim 14.

Paragraph [0003] of Applicant's specification is provided below in its entirety:

[0003] Thermoplastic covering membranes of a covering system for building structures are typically installed using some combination of mechanical fasteners, adhesives applied to the covering membrane and/or the building structure to be covered on-site, and hot air. For example, when the building structure is a roof deck, mechanical fasteners, such as screw and plate combinations are used to hold covering systems comprising roofing membranes to the roof deck at the edges of the roofing membranes. To hold a roofing membrane to a roof deck, adhesives are typically applied to the roofing membranes and/or roof deck at the site of the roofing installation. Generally, an adhesive is applied to a roofing membrane and/or substrate and allowed to set before the membrane is rolled out to adhere the membrane to the substrate. Because an adhesive must be applied on-site and allowed to set, adhering a roofing membrane to a roofing substrate may require a considerable degree of skill and time to perform. To join two roofing membranes that have been adhered to a roof deck, usually hot air is used to weld seams where the two membranes overlap. The seam welds are usually formed using hot air welders that typically cost several thousands of dollars,

making the installation of conventional roofing systems quite expensive, even for professional installers.

As can be seen, Paragraph [0003] says nothing about Claim 14's feature of *adhering two or more building structure peripherals to one or more thermoplastic membranes using a pre-applied adhesive*. Accordingly, Paragraph [0003] cannot remedy the failure of Fischer to teach or suggest this feature of Claim 14.

6. Rejection of Claim 14 over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

Therefore, the combination of Paragraph [0003] with Fischer cannot teach or suggest all of the features of Claim 14 as required by MPEP § 706.02(j) to make a *prima facie* case of obviousness under 35 U.S.C. § 103, and the rejection of Claim 14 under 35 U.S.C. § 103(a) over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

7. Rejection of Claims 21-27 over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

Claims 21-27 are dependent on Claim 14, either directly or indirectly, and, therefore, include all of the features of Claim 14, including the features of Claim 14, discussed above, that are neither taught nor suggested by the combination of Paragraph [0003] with Fischer. Therefore, the rejection of Claims 21-27 under 35 U.S.C. § 103(a) over Fischer either alone or in view of Paragraph [0003] is also *prima facie* improper and should be withdrawn.

8. **Because the Final Office Action mischaracterizes Applicant's Response, the Final Office Action has failed to rebut Applicant's Statement that Claim 18 is patentable over Fischer.**

With respect to Claim 14, Applicant's point on page 10 was not that Claim 18 claimed a pre-applied adhesive instead of Fischer's peel-and-stick adhesive. Instead, Applicant argued the following:

Statement 2

Claim 18 as currently presented claims the feature of *adhering a universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive*, wherein the two or more surfaces are part of one or more thermoplastic membranes adhered to a building structure. *Fischer does not teach or suggest adhering universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive* (See Applicant's Response, p. 10, emphasis added).

However, the Final Office Action has failed to rebut any part of Applicant's Statement 1 above. In fact, because the Final Office Action mischaracterizes Applicant's arguments, as discussed above, the Final Office Action does not even address Applicant's Statement 2. Therefore, Applicant's Statement 2 must be regarded as being true. Accordingly, Fischer cannot teach or suggest Claim 14's feature of *adhering universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive*.

9. **Paragraph [0003] cannot remedy deficiencies of Fischer with respect to Fisher's failure to teach or suggest all of the features of Claim 14.**

Paragraph [0003] of Applicant's specification has been quoted above in its entirety in Section A(5).

As can be seen, Paragraph [0003] states nothing about Claim 18's feature of *adhering universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive*. Accordingly, Paragraph [0003] cannot remedy the failure of Fischer to teach or suggest this feature of Claim 18.

10. Rejection of Claim 18 over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

Therefore, the combination of Paragraph [0003] with Fischer cannot teach or suggest all of the features of Claim 18 as required by MPEP § 706.02(j) to make a *prima facie* case of obviousness under 35 U.S.C. § 103, and the rejection of Claim 18 under 35 U.S.C. § 103(a) over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

11. Rejection of Claims 19-20 and 28-31 over Fischer either alone or in view of Paragraph [0003] is *prima facie* improper and should be withdrawn.

Claims 19, 20 and 28-31 are dependent on Claim 18, either directly or indirectly, and, therefore, include all of the features of Claim 18, including the features of Claim 18, discussed above, that are neither taught nor suggested by the combination of Paragraph [0003] with Fischer. Therefore, the rejection of Claims 19, 20 and 28-31 under 35 U.S.C. § 103(a) over Fischer either alone or in view of Paragraph [0003] is also *prima facie* improper and should be withdrawn.

D. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

Respectfully submitted,



Mark J. Guttag
Reg. No. 33,057

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

December 13, 2006